



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,489	01/30/2002	Steven A. Cover	13768.240	6932

47973 7590 07/12/2005

WORKMAN NYDEGGER/MICROSOFT
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

EXAMINER

ENG, DAVID Y

ART UNIT PAPER NUMBER

2155

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/060,489

Applicant(s)

COVER ET AL.

Examiner

DAVID Y. ENG

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/30/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

PD

Art Unit: 2155

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.

A new abstract that is more aptly descriptive of the invention claimed is requested. It is not clear what the improvement or the problem solved is. Relationship between configuration information, network services and identifier is not clear.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fail to disclose how the configuration information as received by consumer modules would reduce the amount of configuration information manually entered by a user.

The specification fails to disclose how exactly the system identifies and retrieves the particular configuration information associated with the services the particular consumer module will consume by using an email address, a portion or the domain thereof.

The specification fails to disclose the relationship between Figures 1-5. Figure 2 shows the components recited in the claims. However, the specification fails to disclose how Figure 2 is related to the rest of the figures. Where are the consuming computer system, the configuration computer system and the requesting computer system in Figures 1 and 3? Which components shown in Figures 1 and 3 perform the flow charts shown in Figures 4 and 5? How configuration information is retrieved using identifier, email address or domain, etc.? It can be seen that the claims have no support in the specification.

Claims 1-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no functional relationship between the method steps. See steps 1 and 2 in claim 1 for example.

With respect to those claims directed to accessing an identifier including portion of an email address or domain thereof and searching for the configuration information associated with the services the consumer modules will consume, it is not clear as to how exactly the system identifies and retrieves the particular configuration information associated with the services the particular consumer module will consume by using a portion of an email address.

With respect to all independent claims, there is no showing as to how the configuration information as received at the consumer modules would reduce the amount of configuration information manually entered by a user. There is no recitation

Art Unit: 2155

as to how the consumer module is configured by the received configuration information such that the amount of configuration information manually entered by a user is reduced.

With respect to claim 14, it is not seen how the act of searching for configuration information is related to an identifier being redirected.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lalwaney (USP 6,289,377).

With respect to independent claims 1, 22, 25, 42, 43 and 44, see at least the title, the abstract, Figures 1 and 8 and the description thereof in Lalwaney. Compare Applicants' Figure 2 with Lalwaney teaches a method, system and program product for automatically causing configuration information (see "configuration information" in the last 2nd and the last 6th line of the abstract) associated with the services (broadband service) of a service provider (broadband service provider) to be received at consumer modules (cable modem 122 of client PC 120) that consume the services, so as to reduce the amount of configuration information manually entered by a user (see the last line of the abstract), comprising the following:

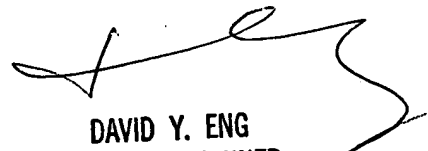
an act the requesting computer system (see the "request" and PPRA in lines 12-13 of the abstract) accessing an identifier representative of services the consumer modules will consume;

an act of the requesting computer system (see the "request" and PPRA in lines 12-13 of the abstract), automatically, and without user intervention, causing a search for configuration information associated with the services the consumer modules will consume;

an act of accessing the configuration information resulting from the search (cable network address server retrieves configuration information, see lines 15-18 of the abstract); and

an act of the consumer modules (cable modem) receiving the accessed configuration information (see the last sentence of the abstract).

With respect to the dependent claims directed to retrieving the configuration information, note that Lalwaney also requires configuration information to be retrieved and forwarded to the consumer module. How exactly the configuration information is indexed to be retrieved is a matter of design choice. It would have been obvious to a person of ordinary skill in the art to store the configuration information in a system in such a way that the configuration information could be retrieved in view of the absent of the disclosure in Applicants' specification.



DAVID Y. ENG
PRIMARY EXAMINER